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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/645,868	08/24/2000	Phillip Orrin Wheeler	8371-112	4031

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EXAMINER

TRAN, DOUGLAS Q

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/645,868

Applicant(s)

WHEELER, PHILLIP ORRIN

Examiner

Douglas Q. Tran

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08/24/00 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4 mailed on 2/2/01</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

1. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Takahashi et al. (US Patent No. 6,281,983 B1).

As to claim 1, Takahashi teaches a method of updating a user interface (21 in fig. 1) of a printer (the copier comprising a printing function which is performed at printer 15 “col. 3, lines 37-40”), comprising:

a) scanning a representative piece of paper (i.e. the original of a paper of the document, col. 11, line 17) creating a scanned image (i.e., a read image of the paper of the original document, col. 11, lines 17-18) of paper to be placed in a print tray (i.e., a feeder would be representative a print tray) of the printer (col. 11, lines 13-15 describes that the original of a

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paper of the document from the feeder is scanned from the feeder and the read image is created “col. 11, lines 17-18”);

b) accessing a document management application to locate and including the scanned image in the application (col. 11, lines 12-16 describes that the user interface “21 in fig. 1” of the copier “fig. 1” allows the operator to depress the preview start key, set the feeder for original document and review of the scanned image “i.e., the original size is detected from the read image, col. 11, lines 17-19”; and, col. 5, lines 10-11, the copier includes CPU 240 “fig. 2B” which controls a program ROM 241. Thus, the copier “fig. 1” inherently comprises a program component corresponding to a document management application for controlling the scanning/printing of the document and displaying the viewing features on the display unit “21 in fig. 1” including the feeder feature and scanned image feature);

c) associating the scanned image with the print tray of the printer using the document management application (col. 11, lines 13-14 describes that the original is transported from the feeder to the original support if the original is set to the feeder and a pre-scan is performed to detect the original size. Thus, the feature of scanned image size is associated with the feature of the feeder in the application program when the preview stat key is depressed); and

d) updating the user interface to reflect the association (col. 11, lines 18-19 describes that the read image is updated and subjected to the preview processing unit 217; and col. 11, lines 24-27 also describes that the data in the image memories in accordance with the CRT characteristics and transferred to the display controller to display a preview image on the CRT. Thus, the user interface is updated to reflect the association).

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As to claim 2, Takahashi discloses every feature discussed in claim 1, and Takahashi further teaches of the scanning is performed by a stand-alone scanner (fig. 1 and col. 3, lines 27-37 indicates that the copier includes a scanner "i.e., a reader unit 12" for scanning an original document; and fig. 9 and col. 10, lines 33-39 indicates the features on the operation unit at the copier would be controlled by the operator for copying or scanning the original "col. 10, lines 66-67". Thus, this copier would be considered as a stand-alone scanner).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al. as applied to claim 1 above, and in combination with Applicant's Admitted Prior Art (page 5, lines 20-22).

As to claim 3, Takahashi discloses every feature discussed in claim 1.

Takahashi does not teach the document management application is SharpDesk.

Applicant's Admitted Prior Art teaches any of document management applications including SharpDesk that can manage scanned images can be used (page 5, lines 20-22).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the document management application of Takahashi to be SharpDesk for managing the document on the display device as taught by Applicant's Admitted

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Prior Art. The suggestion for modifying the document management application of Takahashi can be reasoned by one of ordinary skill in the art as set forth above by Applicant's Admitted Prior Art because the modified document management application from the printing systems would increase the efficiency and flexibility of the printer for adapting to process the variety of formatted documents. The advantage of such modification of the printing systems would allow the printer to install with any of the available document management applications in the commercial products.

As to claim 4, Takahashi discloses every feature discussed in claim 1.

However, Takahashi does not teach the document management application is Adobe Acrobat.

Applicant's Admitted Prior Art teaches any of document management applications including Adobe Acrobat that can manage scanned images can be used (page 5, lines 20-22).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the document management application of Takahashi to be Adobe Acrobat for managing the document on the display device as taught by Applicant's Admitted Prior Art. The suggestion for modifying the document management application of Takahashi can be reasoned by one of ordinary skill in the art as set forth above by Applicant's Admitted Prior Art because the modified document management application from the printing systems would increase the efficiency and flexibility of the printer for adapting to process the variety of formatted documents. The advantage of such modification of the printing systems would allow the printer to install with any of the available document management applications in the commercial products.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas Q. Tran whose telephone number is (703) 305-4857 or E-mail address is Douglas.tran@uspto.gov.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Douglas Q. Tran

Feb. 11, 2004

A handwritten signature in black ink, appearing to read "Tran Douglas", with a long horizontal stroke extending to the right.